

Present :

THE HON. ALFRED C. COXE,

Judge.

JOHANN HOFF,

Complainant,

against

TARRANT & CO.,

Defendant.

At an Equity Term of the Circuit Court of the United States in and for the Southern District of New York, held at the Post Office Building in the City of New York, on the 7th day of February, 1896.

This cause coming on to be heard upon the pleadings and proofs, and after hearing Charles G. Coe, counsel for the complainant, and Fisher A. Baker, counsel for the defendant, and due deliberation having been had thereon, it is

ORDERED, ADJUDGED, AND DECREED, and the Court doth hereby order, adjudge, and decree as follows, namely :

1. That many years ago Johann Hoff commenced to manufacture in the City of Berlin, Germany, a certain fluid preparation or malt extract prepared in accordance with a secret process or formula, which preparation he called, designated, and introduced into public use as Johann Hoff^{ches} Malt Extract, and to sell the same, and the said preparation became widely and favorably known throughout the world by and under said name, and in the United States and other English-speaking countries by and under its anglicized form of name, as Johann Hoff's Malt Extract, and by the abbreviated or shorter form or phrase of Hoff's Malt Extract, under which said latter and shorter or trade name said malt extract became widely known in the commerce of the United States, and was thereafter sold and dealt in under that name as extensively and widely as under the name of Johann Hoff's Malt Extract.

2. That many years ago and prior to January 6th, 1882, the said Johann B. Hoff, trading under the name and style of Johann Hoff, to still further identify and distinguish his said malt extract, commenced to use a certain distinctive label, consisting, in its prominent features, of the representation of certain medals printed on the front of said label, arranged each

side of a coat of arms, the originals of such medals having been received by him from expositions and other institutions, for the excellence of his said preparation, and said labels having printed under said medal line and on the front of said labels the words Johann Hoff^{ches} Malz Extract, and, below said name or words, printed matter in the German language relating to various testimonials received by said Hoff for the excellence of said preparation, and affixed the said labels so arranged and printed to the bottles in which the said preparation or malt extract was sold by him, and continued so to sell the said preparation by and under the names aforesaid and in bottles with said distinctive labels affixed thereto, in various countries in Europe, and in the United States through an agent or agents, until his death in the year 1887.

3. That after the death of said Johann B. Hoff as aforesaid the business of manufacturing and selling the said malt extract was carried on by his two sons and their survivor as general partners, and his widow, daughters, and other relatives as special or silent partners, as the successors in business of said Hoff and under the name and style of Johann Hoff, to some of whom the secret of making and compounding said preparation had been imparted by said Johann B. Hoff during his lifetime for the purpose of enabling said successors to continue the business of manufacturing and selling the genuine preparation or malt extract after his death; and the said malt extract was thereafter manufactured and sold by said successors in business at the City of Berlin and in various other cities of Europe where branches for the manufacture and sale had been established, and the said malt extract manufactured at Berlin by the said successors of Johann Hoff in the said business was continuously sold by said firm of Johann Hoff in the United States through their authorized agent or agents, in like bottles and with like distinctive labels and by and under the said name Johann Hoff's Malt Extract and the trade name Hoff's Malt Extract, as theretofore, by said Johann B. Hoff, until the incorporation of the complainant herein.

4. That the complainant, a corporation organized and incorporated by and under the laws of the State of West Virginia on or about the 27th day of May, 1891, subsequent to said date and prior to the commencement of this suit, commenced to manufacture as well as to sell the genuine Johann Hoff's Malt Extract in the United States, the secret of manufacturing the same having been imparted to one of its officials by the aforesaid firm of Johann Hoff, and the said complainant had during the aforesaid period, at great outlay and at great expense, very widely extended, increased, and popularized the sale of the Johann Hoff Malt Extract manufactured by it as aforesaid and designated and known by the aforesaid distinctive label and by

and under the trade name Hoff's Malt Extract, by which said name the said malt extract was quite as extensively known and designated throughout the United States by the trade and public as by the name Johann Hoff's Malt Extract, and the said complainant corporation had thus built up and acquired a large and valuable business in the manufacture and sale of said Johann Hoff Malt Extract, and was in the possession and enjoyment of the same at the time of the defendant's unlawful acts hereinafter set forth.

5. That the said complainant, subsequent to its incorporation and prior to the commencement of this suit, by assignments and transfers in writing, duly executed and delivered by the said firm of Johann Hoff, had become vested with the exclusive right in and to the good will of the business of the said firm of Johann Hoff in the United States, and in and to the exclusive right to use the aforesaid distinctive label and the aforesaid names in the United States, to designate the malt extract manufactured and sold by said corporation in the United States, the secret of manufacturing and compounding said genuine preparation having been imparted by said firm of Johann Hoff to one of the officials of said corporation, to enable said corporation to manufacture as well as sell the said genuine preparation in the United States, and said corporation, since it commenced to manufacture as well as sell the said malt extract in the United States, has continuously used the said distinctive label, affixed to the bottles in which it sells the Johann Hoff Malt Extract, to designate the same.

6. That the defendant herein, a corporation incorporated by and under the laws of the State of New York, since the incorporation of the complainant, and since the manufacture and sale by the complainant of the said Johann Hoff's Malt Extract in the United States, and since the aforesaid transfers and assignments to the complainant of the exclusive right in and to the good will of said business in the United States, and the exclusive right to use the said distinctive label and names in the United States, by which said good will was symbolized and made known, has continuously sold in the United States a malt extract manufactured by Leopold Hoff in the city of Hamburg, in the Empire of Germany, in bottle with labels affixed thereto, having printed on the front thereof the words "Hoff's Malt Extract," said labelled bottles being provided with metallic caps, on which said caps were imprinted the words, "Genuine Hoff's Malt Extract," and said labelled bottles being put up for shipment in cases having stencilled thereon the words, "Hoff's Malt Extract"; and has also during the like period offered for sale, advertised and represented the said Leopold Hoff's Malt Extract in trade journals, periodicals, and newspapers, and by placards or show cards and otherwise, as the original and genu-

ine Johann Hoff's Malt Extract, and as *Hoff's Malt Extract*, and has also *during the like period designated, represented, and called* by its officials, agents, servants, and others in privity with it the said malt extract so as aforesaid manufactured by Leopold Hoff and sold by the defendant as *Hoff's Malt Extract*, all and every of which said acts of the defendant and of its officials, agents, and servants has been and IS CALCULATED TO DECEIVE AND MISLEAD the trade and public, and to cause the sale and acceptance of the said Leopold Hoff's Malt Extract, manufactured by the said Leopold Hoff and sold by the defendant, as and for Johann Hoff's Malt Extract manufactured and sold by the complainant, *which said acts and conduct had constituted and constitute* AN UNLAWFUL INVASION OF THE GOOD WILL *of the complainant*, AND AN UNFAIR AND INEQUITABLE COMPETITION, which Equity will restrain.

7. That an injunction be forthwith issued herein perpetually restraining and enjoining the defendant corporation herein, its officers, agents, and servants, and all persons in privity with said defendant, from using or causing to be used the words "Hoff's Malt Extract" to designate the preparation manufactured by Leopold Hoff and sold by the defendant, and from selling or offering for sale, advertising or representing by means of labels, circulars, placards, or show cards or publications, or except as hereinafter stated, the malt extract manufactured by Leopold Hoff as "Hoff's Malt Extract," or by any designation of which the words "Johann Hoff's" shall constitute a part.

8. It is not intended by this injunction to restrain the defendant from printing the name "Leopold," in type of the same size, before the words "Hoff's Malt Extract" on labels like the large label affixed to the bottles in which the defendant has sold the malt extract manufactured by said Leopold Hoff, or from using the words "Leopold Hoff's Malt Extract" on labels or otherwise, provided always that in such use the word "Leopold" be made as conspicuous as the word "Hoff's" and said words be not so used in any way or manner as to be a practical violation of this injunction restraining the use of the word "Hoff's."

ALFRED C. COXE, U. S. J.

(Endorsed.) United States Circuit Court, Southern District of New York. Johann Hoff, complainant, against Tarrant & Co., defendant. DECREE.—Charles G. Coe, Solicitor for complainant, 5 Beekman street, New York City.—U. S. Circuit Court, filed February 7th, 1896. John A. Shields, *Clerk*.

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A Copy.

JOHN A. SHIELDS, *Clerk*.